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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/930,235	02/23/1998	ANJA EITRICH	BEIERSDORF45	2748

7590 11/26/2001
NORRIS, MCLAUGHLIN & MARCUS, P.A.
220 EAST 42ND STREET-30TH FLOOR
NEW YORK, NY 10017

EXAMINER

LOVERING, RICHARD D

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 11/26/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

08/930,235

Applicant(s)

EITRICH ET AL.

Examiner

LOVERING

Group Art Unit

1712

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- ☒ Responsive to communication(s) filed on AUG. 10, 2001
- ☒ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-3 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-3 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement

Application Papers

- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some* ☐ None of the:
- ☐ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. _____.
- ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

Office Action Summary

Art Unit: 1712

(1) The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

(2) Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Allard et al. 5,616,331 of record.

Allard et al. (Ex. 1, paragraph bridging cols. 2 and 3; col. 5, lines 47-65; and col. 6, lines 39-47) disclose transparent or translucent microemulsions of the oil-in-water type containing an oil phase e.g. liquid petroleum, cetyl/stearyl alcohol containing 6.6% and glyceryl ^{ear}stearate 3.4%, nano-pigmentary TiO₂ and an aqueous phase, such microemulsions having been obtained by the phase inversion technique. While the microemulsion of Ex. 1 of Allard et al. contains more than 11.8% oil phase, it is evident from Allard et al. (Col. 5, lines 28-43, esp. Lines 34-36) that patentees contemplate the use of as little as 5% oily phase and that 10% oily phase is preferred by them, and it would have been obvious to one skilled in the art to use such low oily phase concentrations in the microemulsions of Allard et al. to render them less expensive by reducing the amount of oily phase relative to the aqueous phase. Moreover, it is well-settled that choice of suitable or optimum concentrations of ingredients is well within the expected skill of a worker in the art. See In re Aller et al., 105 USPQ 233; 220 f. 2d 454.

(3) Claims 2 and 3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Art Unit: 1712

a) Claim 2 recites a Markush group (as to the "parameter" in (d) which is not considered proper for the reasons that it is indefinite as to scope and incomplete as to its membership in reciting "comprising" instead of -- consisting of --; and

b) Claim 3 is indefinite, confusing and improper in using "comprising" when the passive form of verbs is used (thus, "is brought" and "is then cooled). [If applicants insist on using the passive form of verbs, then they should change "which process comprises" in line 2 to--wherein--.

(4) Applicant's arguments filed on August 10, 2001 have been fully considered but they are not persuasive.

The instant claims in "comprising" do not exclude the nanopigmentary TiO₂ of Allard et al. Applicants themselves (page 34, first full paragraph) contemplate including inorganic pigments and prefer TiO₂. Allard et al. (col. 6, lines 39-47) teach that the presence of inorganic nanopigments in no manner interferes with the mechanisms involved in a phase inversion emulsification process.]

(5) Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

Art Unit: 1712

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

(6) Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Lovering whose telephone number is (703) -308-0443. The examiner can normally be reached on Monday through Friday from 7:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Dawson, can be reached on (703) -308-2340. The fax phone number for the organization where this application or proceeding is assigned is (703) -872-9311.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) -308-0661.

Lovering/LR

November 14, 2001

Art Unit: 1712

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Lovering/LR

November 14, 2001

RICHARD D. LOVERING
PRIMARY EXAMINER
GROUP 1200/700

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